

U.S. Appl. No. 09/806,545
Reply to Final Office Action dated August 3, 2006

PATENT
450131-03247

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-13, 15 and 17-24 are pending and are hereby amended. Claims 1-4, 6 and 8 are independent. No new matter has been introduced. It is submitted that these claims, as originally presented, were in full compliance with the requirements of 35 U.S.C. §112. Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §102(e) and §103(a)

Claims 1-3 and 6 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,807,285 to Iwamura (hereinafter, merely "Iwamura") in view of U.S. Patent No. 6,807,285 to Hoyle (hereinafter, merely "Hoyle").

Claims 4, 5 and 7 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Iwamura.

Claims 8-13, 15, 17 and 19-24 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Hoyle in view of Iwamura.

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Claim 18 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Hoyle in view of Iwamura and further in view of U.S. Patent No. 5,809,242 to Shaw, et al. (hereinafter, merely "Shaw").

Claim 1 recites, *inter alia*:

"A system for building an image file comprising:

means for embedding unique identification information which uniquely identifies said image file into a non-displayable portion of said image file;

wherein said unique identification information is added so as to identify access to the image file when a user accesses the image file." (Emphasis added).

As understood by Applicants, Iwamura relates to a data processing apparatus which has a first embedding unit adapted to embed first information in digital image data in accordance with a first embedding method which utilizes publicly available information. The apparatus also has a second embedding unit adapted to embed second information in the digital image data having the first information embedded therein in accordance with a second embedding method which utilizes secret information that is not made publicly available, the second information being used to detect whether the first information is altered.

As understood by Applicants, Hoyle relates to providing an automatically upgradeable software application that includes targeted advertising based upon demographics and user interaction with the computer. The software application is a graphical user interface that includes a display region used for banner advertising that is downloaded from time to time over a network such as the Internet. The software application is accessible from a server via the Internet and demographic information on the user is acquired by the server and used for determining what banner advertising will be sent to the user. The software application further targets the advertisements in response to normal user interaction, or use, of the computer.

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Associated with each banner advertisement is a set of data that is used by the software application in determining when a particular banner is to be displayed.

Applicants submit that Iwamura and Hoyle, taken either alone or in combination, do not teach or suggest the above identified features of claim 1. Specifically, Iwamura and Hoyle do not teach or suggest a system for building an image file comprising means for embedding unique identification information which uniquely identifies said image file into a non-displayable portion of said image file, wherein said unique identification information is added so as to identify access to the image file when a user accesses the image file, as recited in independent claim 1.

The Office Action states that "embedding information that identifies the image such as image format identification data into the image header" meets the limitation of "embedding unique identification information which uniquely identifies said image file". However, as described on column 17, line 64-column 18, line 4 of Iwamura, image format identification data indicates the image format name, a file size, an image width, etc. Image format identification data as taught by Iwamura is not added to the image file so as to identify access to the image file when a user accesses the image file as required in the present claims.

Further, Hoyle merely discloses that a destination link is stored in a banner database which is stored on the client computer's hard drive along with the image files.

Applicants submit that there is no motivation, either in the references themselves, or from the knowledge of one of ordinary skill in the art, at the time the invention was made, to combine the disclosure of Iwamura with the teachings of Hoyle. The Office Action asserts on page 5 that it would have been obvious to "modify the image file of Iwamura to include the pointers taught by Hoyle. One would have been motivated to make such a combination in order

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to provide a secure and authorized way for users to browse through sites on the Internet.”

However, this is a mere wish and hoped-for result, and is not a motivation found anywhere in the prior art of record. Applicants submit that not only does the combination of Iwamura and Hoyle fail to teach or suggest the claimed features, but the combination is improper because it lacks motivation.

Furthermore, Applicants submit that Shaw fails to cure the deficiencies of Iwamura and Hoyle.

Therefore, Applicants submit that independent claim 1 is patentable.

For reasons similar to, or somewhat similar to, those described above with regard to independent claim 1, independent claims 2-4, 6 and 8 are also believed to be patentable.

III. DEPENDENT CLAIMS

The other claims in this application are each dependent on an independent claim discussed above, and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

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Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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